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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,628	11/28/2000	Nancy M. Psaras	END920000142US1	7865

7590  
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02/24/2005

EXAMINER
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WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,628

Applicant(s)

PSARAS ET AL.

Examiner

William H. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-14 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added limitations concerning "client" and client performed actions was not disclosed in Applicant's cited supporting passages. The term client does not appear at all in the original specification. The new matter must be removed.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter and does not have practical applicability. The independent claimed process steps are not useful, concrete and tangible since there is

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no requirement of being performed by a machine. The process is performed in an abstract manner (for example a mental process or on paper).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1 and 3-14 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bowman** (USPN 6,725,399).

#### **Claim 1**

**Bowman** disclosed a process for certifying a software application [by a client] prior to deployment [at said client], comprising:

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- ♦ entering a review request for certification of a software application [by a client prior to deployment at said client,] into a staging database (*column 30, lines 58-59*);
- ♦ assigning a [client] reviewer and scheduling a time for said review (*column 9, lines 50-51; and column 10, lines 4-19*);
- ♦ performing a [client] readiness assessment prior to said time for said review including identifying a [client] business process owner (*column 3, lines 47-57*);
- ♦ conducting said review by said reviewer including providing an overview and process flows identifying control points, providing deliverables, and providing a certification test plan (*column 2, lines 51-56; column 7, lines 24-30; column 8, lines 46-54*);
- ♦ reporting results of said review (*column 2, line 66 to column 3, line 2*); and
- ♦ determining whether said results justify a decision [by said client] of certification of said software application (*column 3, lines 11-16*).

Claim 3

**Bowman** disclosed the process of claim 1, wherein said readiness assessment is performed by answering questions in a checklist (*column 3, line 47 to column 4, line 3*).

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Claim 4

**Bowman** disclosed the process of claim 1, wherein said overview comprises an application environmental overview and an architectural overview (*figure 1, 3.0; column 2, lines 51-56; column 4, line 3*).

Claim 5

**Bowman** disclosed the process of claim 1, wherein said process flows comprise flowcharts (*figures 14-20 and column 7, line 25*).

Claim 6

**Bowman** disclosed the process of claim 5, wherein said flowcharts identify the position of automated or manual control points within the software application (*column 7, lines 30-41; pre-driven*).

Claim 7

**Bowman** disclosed the process of claim 5, wherein said control points include text describing actions to be taken for normal and exception control outcome (*column 7, lines 20-41; predefined*).

Claim 8

**Bowman** disclosed the process of claim 1, wherein said review includes a separation of duties evaluation (*column 9, lines 39-56*).

Claim 9

**Bowman** disclosed the process of claim 1, wherein said review includes an evaluation of control points that prevent unauthorized change to said software application (*column 7, lines 30-41*).

Claim 10

**Bowman** disclosed the process of claim 1, wherein said test plan describes test scenarios and expected results for all said control points (*column 7, lines 30-41; known and predictable results*).

Claim 11

**Bowman** disclosed the process of claim 1, wherein said review further comprises providing a demonstration (*column 7, lines 5-9*).

Claims 12 and 14

The limitations of claims 12 and 14 substantially correspond to claim 1 and as such are rejected in the same manner.

Claim 13

The limitations of claim 13 substantially correspond to claim 11 and as such are rejected in the same manner.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bowman** (USPN 6,725,399).

**Claim 2**

**Bowman** did not explicitly state the process of claim 1, wherein said review request is entered into a spreadsheet database. Official Notice is taken that it was known at the time of invention to make use of spreadsheets for databasing. It would have been obvious to one of ordinary skill in the art at the time of invention to implement **Bowman's** database as a spreadsheet database. This implementation would have been obvious because one of ordinary skill in the art would be motivated to utilize common, "off-the-shelf", technology for at very least the ease of implementation.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.



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***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood  
February 22, 2005

*Kakali Chaki*

**KAKALI CHAKI  
SUPERVISORY PATENT EXAMINER  
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